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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/585,568	06/02/2000	Jens Christian Karger	P19296	5191

7055 7590 12/26/2002

GREENBLUM & BERNSTEIN, P.L.C.
1941 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

JIMENEZ, MARC QUEMUEL

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 12/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/585,568

Applicant(s)

KARGER ET AL. 

Examiner

Marc Jimenez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-27 and 29-60 is/are pending in the application.
- 4a) Of the above claim(s) 4-10,37,40 and 42-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,11-27,29-36,38,39 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. **Claims 4-10, 37, 40, and 42-60** remain withdrawn from consideration as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claim 26** is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 26 recites that the fillers penetrate the radially outer surface. However, claim 1 recites that the outer surface is smooth. It is unclear how the outer surface could be smooth if the fibers penetrate the outer surface.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. **Claim 26** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 26 recites that the fillers penetrate the radially outer surface. However, claim 1 recites that the outer surface is smooth. It is unclear how the outer surface could be smooth if the fibers penetrate the outer surface.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 1, 2, 11, 14-23, 25, 29-33, 35, 36, 38, 39, 41** are rejected under 35 U.S.C. 102(b) as being anticipated by Eddy et al. (4,321,033).

Eddy et al. teach an elastic roller comprising: a hard roller core **17**, an elastic coating layer **19** at an outer side of the hard roller core **17**, the elastic coating layer **19** comprising an elastic matrix material (col. 3, lines 39-43, ie. “elastomer”) and fillers **12** imbedded in the matrix material **19**, wherein a thermal conductivity of the fillers **12** is considerably higher (col. 4, lines 13-15) than a thermal conductivity of the matrix material **19**, and applying the combined elastic matrix material **19** and fillers **12** onto an outer side of the hard roller core **17** to form the elastic coating layer, wherein at least a portion of the fillers **12** comprise metallic fillers (col. 2, lines 47-

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48) arranged in the elastic coating to improve thermal conductivity of the elastic coating layer such that heat will be dissipated toward the hard roller core and dissipated axially by the hard roller core, and wherein the elastic coating layer has a smooth surface structured and arranged for smoothing paper web. With respect to the limitations “heat dissipated toward the hard roller core and dissipated axially by the hard roller core” and “structured and arranged for smoothing a paper web”, the recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Eddy et al. meet the structural limitations of the claims and is clearly capable of performing the intended use. If heat was placed on the outer surface of the roller 16 it would dissipated toward the hard roller core 17. The surface of the roller is smooth 16 and therefore can smooth a paper web if a web is placed on top of the smooth roller 16.

The core is metal (col. 3, lines 22-23), the fillers are metal fibers (col. 2, lines 44-45) aligned in the axial direction, there is a portion of the fibers that is a predominant portion of the fibers (close to the core 17) aligned in statistical distribution arranged in a fiber layer, note the additional fillers 11, the metallic fillers extend up to a radially outer surface of the matrix material (col. 3, lines 29-34), note additional fibers of carbon (col. 2, line 48), note the connecting layer 11, and the matrix material is a plastic material (col. 3, lines 57-61).

With respect to Claim 21, the method of forming the device is not germane to issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 12 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al.

Eddy et al. teach the invention cited above with the exception of the fillers being made of “metal-coated” fibers.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art, to have used “metal-coated” fibers because applicant has not disclosed that metal coated fibers provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant’s invention to perform equally well with either the metal filler taught by Eddy et al. or the claimed “metal-coated” fibers because both fibers perform the same function of increasing the thermal conductivity of the roller. Therefore, it would have been an obvious matter of design choice to modify Eddy et al. to obtain the invention as specified in Claims 12 and 13.

10. **Claim 24** is rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al. in view of Sukenik (3,852,862).

Eddy et al. teach the invention cited above with the exception of the additional fillers comprising at least one of quartz and PTFE.

Sukenik teaches additional fillers comprising at least one of quartz and PTFE (col. 1, lines 60-61).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Eddy et al. with at least one of quartz and PTFE, in light of the teachings of Sukinek, in order to provide light weight conductive fillers.

11. **Claims 26 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al. in view of Brouwer (5,735,388).

Eddy et al. teach the invention cited above with the exception of the fillers penetrating the outer surface or the outer surface is coated with metal.

Brouwer teaches fillers penetrating the outer surface **102**. The outer surface is coated with metal **102**.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of Eddy et al. with fillers penetrating the outer surface or the outer surface coated with metal, in light of the teachings of Brouwer, in order to provide a friction enhancing surface.

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12. **Claim 34** is rejected under 35 U.S.C. 103(a) as being unpatentable over Eddy et al. in view of Yamamoto et al. (4,990,963).

Eddy et al. teach the invention cited above with the exception of the plastic material comprising one of thermosetting resin or thermoplastic material.

Yamamoto et al. teach using thermosetting resins (col. 3, lines 49-54).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provide the invention of Eddy et al. with thermosetting resins, in light of the teachings of Yamamoto et al., in order to provide a resin material that is elastic and retains its form.

Response to Arguments

13. Applicant's arguments with respect to **Claims 1, 2, 11-27, 29-36, 38, 39, and 41** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Interviews After Final

15. Applicant note that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing) to clarify issues for appeal requiring only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations will be denied. See MPEP 714.13 and 713.09.

Contact Information

16. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information. M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, or fax (703) 872-9301 or by email to CustomerService3700@uspto.gov.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Jimenez whose telephone number is **703-306-5965**. The examiner can normally be reached on **Monday-Thursday and the second Friday of the bi-week, between 9am-6pm.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.


Allowed Files & Publication	(703) 308-6789 or (888) 786-0101
Assignment Branch	(703) 308-9723
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Petitions/Special Programs	(703) 305-9285
Terminal Disclaimers	(703) 305-8408
PCT Help Desk	(703) 305-3257

If the information desired is not provided above, or a number has been changed, please call the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/


MJ

December 20, 2002


GREGORY VIDOVICH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700